

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1, 4, 5, 8, 9-11 and 13-26 are pending in the application. Applicants respectfully submit that the pending claims define patentable subject matter.

I. Rejections under 35 U.S.C. §112, First Paragraph

Claims 20, 23 and 25 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. By this Amendment, Applicant directs the Examiner's attention to the following passages that provide support for claims 20, 23 and 25. Support for claim 20, for example, can be found on page 5, lines 15-16 of the specification. Likewise, support for claim 23 can be found on page 19, lines 19-20 of the specification. Support for claim 25 can be found on page 15, lines 4-5 of the specification. Accordingly, the Examiner is requested to withdraw the rejections.

II. Rejections under 35 U.S.C. §112, Second Paragraph

Claims 1, 4, 5, 8, 17 and 19-26 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. In particular, the Examiner asserts that claims 1 and 17 are unclear to whether the Applicants intend to claim a system or method because the preamble of each claim recites a system comprising a systems components with method steps. The Examiner cites *IPXL Holdings, LLC v. Amazon.Com, Inc.* (CAFC, 05-1009, 1487 11/21/2005) in support of his position. Applicants respectfully disagree.

Applicants respectfully submit that the 35 U.S.C. §112, second paragraph rejection is improper in view of *IPXL Holdings, LLC v. Amazon.Com, Inc.* and MPEP § 2173.05(p)(II) (1999). As recited in *IPXL Holdings, LLC*, "a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. §112, second paragraph" (emphasis added). Claim 1 directed to "[a] system for accessing pharmacy data and ordering prescriptions via a network." Claim 1 recites:

a network server connected to the network that is accessible by one or more customers via the network;

an application server connected to the network server;

a database connected to the application server, the database containing information concerning drugs and personal information concerning one or more of the customers, wherein the personal information includes a prescription drug history of each respective one of the one or more customers; and

an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, the intranet server being connected to the application server;

wherein the application server is configured to:

receive a username and password from a customer;

cause a browser to display to the customer the information concerning drugs and personal information concerning that customer if the username and password are confirmed, and

cause the browser to display an option to transmit a prescription order to at least one of the plurality of member pharmacies or one of the one or more shipping facilities,

receive the prescription order and perform a prescription drug interaction check;

receive an indication of a choice from the customer relative to the option;

cause at least one prescription drug associated with the prescription order to be shipped from the one of the one or more shipping facilities when the customer chooses the option to transmit the prescription order to the one or more shipping facilities; and

cause at least one prescription drug associated with the prescription order to be filled at one of the local member pharmacies when the customer chooses the option to transmit the prescription order to the one local member pharmacy for pick-up by the customer.

Claim 1 does not recite a method for using any apparatus recited in the claim. This is expressly apparent from claim 1 because claim 1 states in part: "the application server is configured to: cause a browser ..." Rather, claim 1 merely recites at least one apparatus (e.g.

application server) performing functions. In *IPXL Holdings, LLC*, the invalid claim read in part as the following:

The system of claim 2 [including an input means] wherein the predicted transaction information comprises ...and the user uses the input means to either change the predicted transaction information (emphasis added)

Unlike the system claim 2 of *IPXL Holdings, LLC*, claim 1 does not recite any language that can be construed as a method for using the apparatus recited in claim 1. In fact, claim 1 never even recites “using” or a similar verb in connection with an apparatus recited in claim 1 as in the case of system claim 2 of *IPXL Holdings, LLC*.

Furthermore, as shown above, claim 1 recite apparatuses, or structures (e.g. network server, database, etc.) that have functions described in the system. In other words, every structure has a corresponding function.. 35 U.S.C. §101 defines “an article of manufacture, a composition of matter, a process, or improvement thereof” as statutory subject matter. It is well-settled by the case law and the M.P.E.P. that a system claim, like claim 1, qualifies as one statutory class, not two or more statutory classes mixed together. This is apparent from the case law and the M.P.E.P. For example, if the structure did not perform a function, then structures of the system would not be able to interact with each other. As a result, the claim would be merely an aggregation of elements¹, which is clearly impermissible. As such, an aggregation of elements may result in a 35 U.S.C. §112, first paragraph, lack of enablement rejection and/or 35 U.S.C. §112, second paragraph, indefinite rejection².

Thus, claim 1 is proper in its current form and should not have been rejected under 35 U.S.C. §112, second paragraph. Similarly, claim 17 recites features that are similar with regard to claim 1. In particular, these features include: “wherein the application server is configured to: receive a username and a password from a customer ...” For at least these reasons, claim 17 is also proper in its current form and should not have been rejected under 35 U.S.C. §112, second paragraph. Claims 4, 5, 8 and 20-26 are dependent on claims 1 and

¹ See M.P.E.P. §2173.05 (k) titled “Aggregation”

² See M.P.E.P. §2172.01 titled “Unclaimed Essential Matter”

17, respectively. By virtue of their dependency, claims 4, 5, 8 and 20-26 are proper in their current form and should not have been rejected under 35 U.S.C. §112, second paragraph.

Accordingly, the Examiner is respectfully requested to withdraw the rejections.

III. Prior Art Rejections

Claims 1, 4, 5, 8-10, 15-20, 23 and 26 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Szabo (U.S. 5,954,640; hereinafter "Szabo"), article entitled "Name Change Reflects CVS' Commitment to E-commerce" (hereinafter "Name Change article") and Mayaud (U.S. 5,845,255; hereinafter "Mayaud"). Claims 13 and 14 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Szabo, Name Change article, Mayaud and Godin et al. (U.S. 2001/0009005; hereinafter "Godin"). Claims 11, 21, 22, 24 and 25 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Szabo, Name Change article, Mayaud, Godin and McCormick (US 2002/0035484 A1; hereinafter "McCormick"). Applicant respectfully submits that the claimed invention would not have been rendered obvious in view of Szabo, alone or in combination, with Name Change article, Mayaud Godin and/or McCormick.

The Examiner alleges that Szabo discloses many of the features of independent claim 1 and relies on Name Change article and Mayaud to cure the deficiencies not taught by Szabo. The Examiner cites paragraph 4-5 of Name Change article as disclosing "an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities." For example, paragraphs 4-5 of Name Change article states in part: "consumers who place an order can opt to have the items shipped." However, no portion of the Name Change article discloses "an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities," as required by claim 1 (emphasis added). Rather, the Name Change article merely discloses customers place orders for goods via CVS' website, not a plurality of member pharmacies. Further, Applicant kindly points the Examiner attention to page 7 of the Office Action. On page 7 of the Office Action, the Examiner concedes that Szabo does not expressly disclose "an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities," as recited in claim (emphasis added).

Similarly, Mayaud, Godin and McCormick do not teach or suggest these features of the claimed invention which are missing from Szabo and Name Change article.

Accordingly, Applicants respectfully submit that independent claim 1, as well as dependent claims 4, 5, 8 and 20-26 should be allowable because the cited references, alone or in combination, do not teach or suggest all of the features of the claimed invention, and one of ordinary skill in the art would not have been motivated to combine the cited references to produce the claimed invention.

Independent claims 9, 17, 18 and 19, recite similar features to those discussed above with regard to claims 1. In particular, these features include "a plurality of member pharmacies." Accordingly, claims 9, 17, 18 and 19, as well as their respective dependent claims 10, 11 and 13-16, are patentable at least for the reasons mentioned for claim 1.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Dated: July 25, 2008

Respectfully submitted,

By 
Anthony V. Whittington, Esq.

Registration No.: 54,871
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant